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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,141	01/17/2002	Jin-Yong Joo	1522.1003	3416

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EXAMINER

CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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09/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	09/763,141	JOO ET AL.
	Examiner	Art Unit
	Jeffrey D. Carlson	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 July 2007.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-10 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/17/02</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This action is responsive to the paper(s) filed 7/12/07.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7, 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 7, it is unclear whether the "depriving" is a positive step or an optional one because it is apparently only performed "when the email is confirmed..."
- Claim 7, there is no antecedent basis for any membership.
- Claim 7 includes the possibility of not compensating the sender, yet claim 1 requires such a payment and therefore provides a conflict.
- Claim 8, there is no antecedent basis for the downloading.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild (US20010047294).

Regarding claims 1, 5, 9, Rothschild teaches the concept of allowing an email sender to send an email message that includes a sender-chosen advertisement to an email recipient. Both the sender and receiver may be compensated for the advertising [abstract, para 0021, 0022]. While Rothschild appears to describe a typical "webmail" application [0047] where the mails are delivered from the server, the system can also be described as one where the sender's PC transmits the emails because the sender's PC is the one which presses the "send" button and authorizes the delivery of the email. Without the sender's PC, no mail would be transmitted. However, Rothschild also teaches that the recipient may use a typical desktop email client such as Microsoft Outlook™ and it would have been obvious to one of ordinary skill at the time of the invention to have provided the ability for senders to transmit emails with desktop clients as well for users more comfortable with an application program rather than webmail. When an advertisement is chosen and included with the email, it can be said to be an "activated" advertisement now included with the email. Rothschild describes that the server can collect information regarding the sending and receiving/interacting of the advertisements and the system will compensate the user's accordingly [0054, 0056, 0057]. In the case where the sender uses a desktop application, such notifications would be delivered to the server from the client PC.

Regarding claims 2, 10, Rothschild teaches that ads may include embedded URLs; these are taken to represent ads inserted into the ground of the email. However,

HTML-formatted emails are well known to include various HTML features including background content (in fact Outlook supports such features) and it would have been obvious to one of ordinary skill at the time of the invention to have inserted any advertising content into the foreground or background of the email as a matter of design choice. Compensating for interacting with an interactive advertisement is also taken to represent compensation for receiving the advertisement as the advertisement cannot be interacted with without its receipt. The two go hand-in-hand. Nonetheless, it would have been obvious to one of ordinary skill at the time of the invention to have compensated recipients for merely receiving a "static" ad because it is well known for advertisers to pay per advertisement "impression".

Regarding claims 3, 4, 8, the webmail application of Rothschild is taken to include downloading ads to the client's browser page for display and review before the personalized message is added and email is submitted for delivery. Further, Rothschild teaches that the sender may be the source for the advertisement [0049 lines 10-13].

Regarding claim 6, the advertisement itself and being able to experience it can be taken to be a free gift.

Regarding claim 7, Rothschild teaches techniques to punish the sender for SPAM abuse of the system and/or fraud [0068].

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-

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6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc